

REMARKS

The Office Action mailed May 11, 2007 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendment to the Claims

Claims 1 and 58-126 are now pending.

No claims stand allowed.

Claims 81, 86-88, 91-97, 121, 122, and 125 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification and figures as originally filed. The text of claims 82-85, 89, 90, 98, 123, 124, and 126 is unchanged, but their meaning is changed because they depend from amended claims.

Objections To The Claims

Claims 81-98 stand objected to for various informalities, of which Claims 81, 88, and 96 are independent claims.¹ With this Amendment, Claims 81, 86-88, and 91-97 have been amended accordingly. Withdrawal of the objection to the Claims is respectfully requested.

The 35 U.S.C. § 112, Second Paragraph Rejection

Claims 65-77 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.² This rejection is respectfully traversed.

¹ Office Action at ¶ 5.

² Office Action mailed May 11, 2007, at ¶ 1.

According to the M.P.E.P.,

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.³

The Examiner states:

Referring to claim 65, 77, what is meant by "presenting to a user a list of the candidate network devices qualified to join the cluster prior to said adding"?

Referring to claim 66, what is meant by "presenting to a user a list of the first candidate network devices qualified to join the cluster"?⁴

The Specification recites in part:

At step 320, the commander device applies qualification rules to determine whether each is qualified to join the cluster. At step 330, the commander device produces a list of Ethernet addresses of candidate switches that meet the qualification rules. At step 340, a user selects a candidate device from the list to be added to the cluster.⁵

The Applicant respectfully submits that in light of this particular application disclosure, one of ordinary skill in the art would understand that at step 340, the user selects a candidate device from the list produced at 330, and that the list produced at 330 must be presented to the user so that the user may select a candidate device in the list. Accordingly, withdrawal of the 35 U.S.C. § 112, second paragraph rejection of Claims 65-77 is respectfully requested.

The 35 U.S.C. § 101 Rejection

³ M.P.E.P. § 2173.02.

⁴ Office Action at ¶ 1.

⁵ Specification at p. 50 ll. 9-14 and FIG. 15.

Claims 121-126 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory matter.⁶

The Examiner states:

... the claims are directed to a program storage device which is readable by a machine tangibly embodying a program of instructions. The format of these claims is not correct. In order to be statutory the applicant needs to claim A computer readable medium which stores instructions which are executable on a computer in which said instructions perform the method comprising:⁷

With this Amendment, independent claims 121, 122, and 125 have been amended to recite in part “A computer readable medium which stores instructions which are executable on a computer in which said instructions perform a method ...” Accordingly, withdrawal of the 35 U.S.C. § 101 rejection is respectfully requested.

The Judicially-Created Double Patenting Rejection

Claims 1 and 58-65 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 1 of prior United States Patent No. 6,636,499 (“’499 patent”).⁸

Claims 66-77 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 35 of the ‘499 patent.⁹

Claims 78-80 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of the ‘499 patent.¹⁰

⁶ Office Action at ¶ 2.

⁷ Office Action at ¶ 2.

⁸ Office Action at p. 2.

⁹ Office Action at p. 2.

¹⁰ Office Action at p. 4.

Claims 81-87 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of the '499 patent.¹¹

Claims 88-91 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of the '499 patent.¹²

Claims 96-98 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of the '499 patent.¹³

Claims 99-107 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of the '499 patent.¹⁴

Claims 108-117 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of the '499 patent.¹⁵

Claims 118-120 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of the '499 patent.¹⁶

Claim 121 stands rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 31 of the '499 patent.¹⁷

¹¹ Office Action at p. 4.

¹² Office Action at p. 4.

¹³ Office Action at p. 4.

¹⁴ Office Action at p. 5.

¹⁵ Office Action at p. 5.

¹⁶ Office Action at p. 5.

¹⁷ Office Action at p. 5.

Claims 122-124 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 66 of the '499 patent.¹⁸

Claims 125-126 stand rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claim 78 of the '499 patent.¹⁹

Submitted herewith is a Terminal Disclaimer executed by the Attorney of Record in both the above-identified patent application and in United States Patent No. 6,636,499. Accordingly, withdrawal of the rejection of Claims 1, 58-65, 66-67, 78-80, 81-87, 88-91, 96-98, 99-107, 108-117, 118-120, 121, 122-124, and 125-126 pursuant to the judicially-created doctrine of obviousness-type double patenting is respectfully requested.

The First 35 U.S.C. § 102 Rejection

Claims 1, 58-80 and 122-126 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Meier et al.²⁰ This rejection is respectfully traversed.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.²¹

Claim 1

Claim 1 recites:

¹⁸ Office Action at pp. 5-6.

¹⁹ Office Action at p. 6.

²⁰ U.S. Patent No. 6,046,992 to Meier et al.

²¹ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

A method for discovering and configuring network devices into a cluster, said method comprising:
automatically detecting candidate devices by receiving discovery packets from the candidate devices, the candidate devices periodically transmitting the discovery packets;
determining whether any of the candidate devices is qualified to join the cluster by applying qualification rules to the discovery packets received from the candidate devices; and
adding one or more of the candidate devices to the cluster to be managed and configured via a commander network device of the cluster.

The Examiner states:

... Meier teaches: A method for discovering and configuring network devices into a cluster said method (Fig 1 performs the method) comprising: automatically detecting candidate devices by receiving discovery packets from the candidate devices, the candidate devices periodically transmitting the discovery packets (Root receives Attach request or discovery packet per col. 5 line 36 to 67 determining whether any of the candidate devices is qualified to join the cluster by applying qualification rules to the discovery packet received from the candidate devices (Root only receives Attach request from terminals which are either unattached or detached or rule per col. 3 lines 25 to col. 4 line 67) and adding one or more of the candidate devices to the cluster to be managed and configured via a commander network device of the cluster (The root (commander network device) adds the terminal or candidate to the spanning tree or cluster by sending Attach confirm per col. 5 line 33 to 67)²²

The Applicant respectfully disagrees for the reasons set forth below.

Meier et al. Does Not Teach Determining Whether Any Of The Candidate Devices Is Qualified To Join The Cluster By Applying Qualification Rules To The Discovery Packets Received From The Candidate Devices

Contrary to the Examiner's statement, Meier et al. does not teach determining whether any of the candidate devices is qualified to join the cluster by applying qualification rules to the discovery packets received from the candidate devices as required by Claim 1. In support of the Examiner's statement, the Examiner states parenthetically "Root only receives Attach request from terminals which are either unattached or detached or rule per col. 3 lines 25 to col. 4 line

67.”²³ The Examiner appears to be saying that making an assumption based on the fact that a packet was received as disclosed in Meier et al. is the same as applying a rule to a received packet as claimed in Claim 1. The Applicant respectfully submits the Examiner’s attempt to equate applying qualification rules to discovery packets received from candidate devices, with an assumption made about a received packet, is improper. The Examiner is reminded that the mere absence from a reference of an explicit requirement of a claim cannot be reasonably construed as an affirmative statement that the requirement is in the reference.²⁴ For this reason, the 35 U.S.C. § 102(e) Rejection of Claim 1 is unsupported by the cited art of record.

Meier et al. Does Not Teach Adding One Or More Of The Candidate Devices To The Cluster To Be Managed And Configured Via A Commander Network Device Of The Cluster

Meier et al. teaches a radio frequency local area network in which an optimum configuration (spanning tree) is created in order to control the flow of data communication and to route data efficiently, dynamically, and without looping.²⁵ Thus, although a new node (bridge, gateway, or RF terminal) may be attached to the spanning tree in accordance with certain criteria (logical distance from the root node), the attached device is used only to provide an optimum data communication path in the network. As the Examiner correctly noted regarding allowable subject matter in an Office Action for the parent application, Meier et al. does not teach adding one or more of the candidate devices to the cluster to be *managed and configured* via a commander network device of the cluster, as recited in Claim 1.²⁶ For this additional reason, the

²² Office Action, pp. 6-7.

²³ Office Action, pp. 6-7.

²⁴ *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

²⁵ Meier et al. at col. 2 ll. 24-26 and 36-37.

²⁶ U.S. Patent Application Serial No. 09/453,163, Office Action mailed January 29, 2003, p. 22. (emphasis added)

35 U.S.C. § 102(e) Rejection of Claim 1 is unsupported by the cited art of record. Thus, a *prima facie* case has not been made and the rejection must be withdrawn.

Claim 66

Claim 66 includes the same distinctive features as that in Claim 1, and thus the argument set forth above with respect to Claim 1 is equally applicable to Claim 66.

Claim 78

Claim 78 recites:

A method for discovering candidate network devices to be configured into a cluster of network devices and managed via a commander network device, said method comprising:
periodically transmitting discovery packets from the candidate network devices, the discovery packets including information indicating that the candidate network device is capable of belonging to a cluster;
maintaining, at each of the candidate network devices, a neighbor device database containing information about other candidate network devices directly connected to the candidate network device; and
transmitting the information in the neighbor device database to the commander network device when the candidate network device is added to the cluster.

The Examiner states:

... a method for discovering candidate network device to be configured into a cluster of network devices and managed via a commander network device (Fig 1 performs the method), said method comprising: periodically transmitting discovery packets from the candidate network devices the discover packets including information indicating that the candidate device is capable of belonging to a cluster (Terminal transmits Attach request or discovery packet indicating that the terminal or candidate network device is capable of belonging to the spanning tree or cluster per col. 5 line 36 to 67 maintaining at each candidate network device a neighbor database containing information about other candidate network devices directly connected to the candidate network device (Each terminal keeps a Child list or other network devices directly connected to the terminal or candidate device per col. 12 lines 64 to 67) and transmitting the information in the neighbor device data base to the commander network device when the candidate network

device is added to the cluster (Child list is forwarded to root as a part of attach request per col. 12 lines 64 to 67) and²⁷

The Applicant respectfully disagrees. Again, the Examiner appears to be saying that making an assumption based on the fact that a packet was sent by a candidate network device as disclosed in Meier et al. is the same as including information in the packet indicating that the candidate network device is capable of belonging to a cluster as claimed in Claim 78. The Applicant respectfully submits the Examiner's attempt to equate the two is improper. For this reason, the 35 U.S.C. § 102(e) Rejection of Claim 78 is unsupported by the cited art of record.

Claims 121, 122, and 125

Claims 121, 122, and 125 are *In re Beauregard* claims corresponding to method claims 1, 66, and 78, respectively. Claims 1, 66, and 78 being allowable, Claims 121, 122, and 125 must also be allowable for at least the same reasons.

Claims 58-65, 67-77, 79-80, 123-124, and 126

Claims 58-65 depend from Claim 1. Claims 67-77 depend from Claim 66. Claims 79-80 depend from Claim 78. Claims 123-124 depend from Claim 122. Claim 126 depends from Claim 125. The base claims being allowable, the dependent claims must also be allowable.

Claim 61

Claim 61 recites:

The method according to claim 1, wherein the discovery packets include cluster-capability information of the candidate device transmitting the discovery packets.

The Examiner states:

²⁷ Office Action, p. 9.

... wherein the discovery packets include cluster-capability information of the candidate device transmitting the discovery packets (attach request only sent if terminal or candidate unattached or detached).²⁸

The Applicant respectfully disagrees. Claim 61 requires the discovery packets *include* cluster-capability information of the candidate device transmitting the discovery packets. This is not shown by Meier et al. Again, the Applicant respectfully submits the Examiner's attempt to equate the fact that a packet has been transmitted, with including information in that packet, is improper. For this additional reason, the 35 U.S.C. § 102 rejection of Claim 61 is unsupported by the cited art of record and must be withdrawn.

Claims 64 and 73

Claim 64 recites:

The method according to claim 63, further comprising:
transmitting, in response to said adding, the information about the neighbor candidate information to the commander network device from each member network device which just joined the cluster.

The Examiner states:

... further comprising transmitting in response to said adding the information about the neighbor candidate information to the commander network device from each member network which just joined the cluster (Child List per col. 12 lines 63 to 67).²⁹

The Applicant respectfully disagrees. Claim 64 requires that the transmitting step recited in Claim 1 be responsive to the adding step recited in Claim 1. In support of the Examiner's contention, the Examiner refers to a portion of Meier et al. that discloses ATTACH requests *contain* a CHILD list. Thus, the transmitting of the CHILD list disclosed in Meier et al. cannot be said to be *responsive* to the adding. For this additional reason, the 35 U.S.C. § 102 rejection of Claims 64 and 73 is unsupported by the cited art of record and must be withdrawn.

²⁸ Office Action, p. 7.

Claims 65 and 77

Claim 65 recites:

The method according to claim 1, further comprising:
presenting to a user a list of the candidate network devices qualified to join the
cluster prior to said adding.

The Examiner states:

... presenting to a user list of the candidate network devices qualified to join the
cluster prior to said adding (Hello request are sent to terminals and bridges which
are unattached or detached or qualified to join).³⁰

The Applicant respectfully disagrees. Claim 65 requires presenting a user list of the candidate
network devices qualified to join the cluster prior to said adding. The Examiner's statement
makes no reference to the portion of Meier et al. supporting the statement. Nowhere does Meier
et al. disclose presenting to a user list of the candidate network devices qualified to join the
cluster prior to said adding as required by Claim 65. For this additional reason, the 35 U.S.C. §
102 rejection of Claims 65 and 77 is unsupported by the cited art of record and must be
withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition
for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into
condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

²⁹ Office Action, p. 7.

³⁰ Office Action, p. 7.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

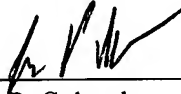
The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID BROWN
RAYSMAN & STEINER LLP

Dated: August 13, 2007



John P. Schaub
Reg. No. 42,125

THELEN REID BROWN RAYSMAN & STEINER LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040